

Amendment & Response

Serial No.: 10/702,369

Confirmation No.: 8480

Filed: 6 November 2003

For: BEAK TREATMENT WITH TONGUE PROTECTION

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Remarks

The Office Action of 20 April 2007 has been received and reviewed. No claims have been amended or canceled and new claims 28 & 29 are presented, leaving claims 1-5 and 8-29 pending upon entry of the amendments presented above. Reconsideration and withdrawal of the rejections are respectfully requested.

Allowable Claims

Applicants note that claims 22 and 23 are indicated as allowable, and that claims 14 and 18 would be allowable if rewritten in independent form.

New Claims 28 & 29

New claims 28 and 29 are presented to provide Applicants with more comprehensive protection of the inventions described in the application. Support for new claims 28 and 29 can be found in, e.g., the original claims, Figures 1-4, and in the specification at page 6, lines 9-22; page 7, lines 21-27; page 9, lines 3-17; etc.

The 35 U.S.C. § 103 Rejection

Claims 1-13, 15-17, and 24-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gourlandt (U.S. Patent No. 4,446,819) in view of Meyn (Netherlands Patent NL 8802812 A). This rejection is respectfully traversed as discussed herein.

At the outset, it is noted that claims 19-21 were not noted as being rejected in the Office Action. However, claims 19-21 were referenced in the body of the rejection. For purposes of this response, Applicants assume that claims 19-21 are rejected under the same rejection.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

M.P.E.P. § 2143.

Applicants submit that the proposed combination of Gourlandt in view of Meyn does not establish a *prima facie* case of obviousness for claims 1-5, 8-13, 15-17, 19-21, and 24-27 because the references, taken alone or combined, do not teach or suggest all of the claim limitations.

Independent claims 1, 11, 15, 20-21, and 26-27 each recite, *inter alia*, a tongue control protrusion either protruding from a surface defining the beak receiving aperture in the bird head positioning device (claims 1, 11, 15), extending into the beak receiving aperture, wherein the tongue control protrusion is fixedly mounted and located within the beak receiving aperture (claim 20), fixedly mounted within the beak receiving aperture (claim 21), or protruding directly from a surface defining the beak receiving aperture in the bird head positioning device (claims 26-27). Independent claim 19 recites, *inter alia*, a tongue control protrusion extending into the beak receiving aperture, wherein the tongue control protrusion is fixedly mounted relative to the beak receiving aperture for the bird head positioning device.

Gourlandt does not, as asserted, teach or suggest a tongue control protrusion as recited in independent claims 1, 11, 15, 19-21, and 26-27. For example, Gourlandt does not teach a tongue control protrusion protruding from or located within a beak receiving aperture. Instead, the control bar 62 (which is equated in the Office Action with the claimed tongue control protrusion) extends from post 88, which is clearly outside of the identified recess 54. In fact, the Office Action admits as much when reciting that "Gourlandt . . . is silent on explicitly teaching that the tongue control protrusion is protruding from a surface defining the beak receiving aperture in the bird head positioning device." *Office Action*, 20 April 2007, page 3.

Nor does Gourlandt teach a tongue control protrusion that is fixedly mounted. Instead, the post 88 (to which the control bar 62 is attached) pivots, and, as a result, the control

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bar/protrusion 62 is not fixedly mounted. In an attempt to cure these deficiencies, the following assertions are provided in the Office Action:

However, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Gourlandt at the time of the invention since the modification is merely eliminating an element and its function. Elimination of an element and its function when that function is not desired is an obvious modification. In instances when it is desirable to manually hold the poultry in place it is not necessary to have the spring activated features (Gourlandt #84, 66, 74) and is desirable to merely have the known tongue control protrusion in place secured to the surface of the beak receiving aperture performing the same intended function of controlling the poultry tongue i.e. merely shifting the attachment point of the tongue control protrusion for manual operation is an obvious modification for one of ordinary skill in the art.

Office Action, 20 April 2007, page 3 (emphasis added).

These assertions are not, however, supported by the references themselves and, as discussed below, cannot form the basis for a *prima facie* case of obviousness.

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. § 2143.01(V) (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

Modification of Gourlandt as proposed would render the Gourlandt invention unsatisfactory for its intended purpose. Gourlandt clearly and repeatedly recites that one of its intended purposes is automatically supporting and restraining birds. For example, Gourlandt expressly recites that "[t]he invention essentially relates to a method and an apparatus for automatically supporting and restraining notably birds." *Gourlandt*, column 1, lines 12-14. Further, the title of Gourlandt recites a "METHOD AND AN APPARATUS FOR AUTOMATICALLY SUPPORTING AND RESTRAINING BIRDS." Still further, every independent claim of Gourlandt recites a method or an apparatus "for automatically supporting and restraining live animals including birds." *Gourlandt*, claims 1-2 and 15. Accordingly, it cannot be disputed that the intended purpose of Gourlandt is automatically supporting and restraining birds.

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The proposed modification used to support this obviousness rejection would, however, eliminate the automatic support and restraint features of Gourlandt (i.e., the spring activated features of elements 84, 66, 74) to convert the apparatus over for manual operation. Requiring an operator to manually hold the poultry in place would render the invention of Gourlandt unsatisfactory for its intended purpose (i.e., automatically supporting and restraining birds).

Further, nothing is identified within the teachings of the references that shows that manual operation of the apparatus and method in Gourlandt is desired as asserted in the Office Action. In light of the remarks herein regarding the purpose of Gourlandt, it is not desirable to modify Gourlandt for manual operation for at least the reason that the principle purpose of Gourlandt is automatically supporting and restraining birds. Therefore, applying the doctrine of M.P.E.P. § 2144.02(II)(A)) as asserted in the Office Action in which "omission of an element and its function is obvious if the function of the element is not desired" is not applicable because, the function of the removed elements, i.e., automatically supporting and restraining birds, is clearly desirable.

Further, the secondary reference (Meyn) cited in combination with Gourlandt to support this obviousness rejection does not address the deficiencies of this rejection as identified above.

For at least the reasons presented above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to independent claims 1, 11, 15, 19-21, and 26-27 over Gourlandt in view of Meyn. Applicants further submit that dependent claims 2-5, 8-10, 12-13, 16-17, and 24-25, which directly or ultimately dependent on independent claim 1, 11, 15, 19-21, or 26-27, are patentable for the reasons presented above with respect to the independent claims.

Reconsideration and withdrawal of the obviousness rejection of claims 1-5, 8-13, 15-17, 19-21, and 24-27 are, therefore, respectfully requested.

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Response to Office Action's Response to Arguments

It is asserted in the Office Action that "Applicant has not claimed that the protrusion is directly protruding from the surface of the bird head positioning device." *Office Action*, 20 April 2007, page 7. Applicants respectfully disagree. Both independent claims 26 and 27 each recite a "tongue control protrusion protruding directly from a surface defining the beak receiving aperture in the bird head positioning device." As a result, Applicants respectfully request reconsideration and review of the recitations of claims 26 and 27.

It is also asserted in the Office Action that "the concept of a protrusion in relation to a bird head receiving aperture is known and merely shifting the location of a known element that performs the same intended function is an obvious modification for one of ordinary skill in the art." *Office Action*, 20 April 2007, page 7. The intended function of the control member 62 (which is equated with the claimed tongue control protrusion) is, however, "for actuation of said cam with the aid of a linkage so as to allow said spring to close the retainers upon a bird when the bird is pressed against the control member." *Gourlandt*, column 2, line 68 to column 3, line 3. If the control member 62 is moved as proposed in support of the obviousness rejection, the control member 62 cannot perform its intended function, i.e., actuating the suspending means of *Gourlandt*. As a result, Applicants respectfully submit that these assertions are not supported by the reference and should be withdrawn.

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Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

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17 OCTOBER 2007

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Direct Dial (612) 305-1218**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17th day of October, 2007, at 2:17 pm (Central Time).

By: Deb Schurmann
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